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EXAMINER	
BACHMAN, LINDSEY MICHELE	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK H. FALAHEE

Appeal 2009-011649
Application 10/805,856
Technology Center 3700

Before: LINDA E. HORNER, WILLIAM F. PATE III, and
KEN B. BARRETT, *Administrative Patent Judges*.

PATE III, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims 1, 3 and 4. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

The claims are directed to a wound and skin closure instrument. Claim 1, reproduced below, is illustrative of the claimed subject matter:

> 1. An instrument for closing skin edges forming a wound, the instrument comprising:
>
> a pair of opposing wheels that rotate in the same direction, enabling the instrument to be pulled along a wound to progressively bring skin edges together;
>
> a breakable vial or fillable reservoir of skin glue; and
>
> a device to supply the glue to the skin edges being brought together.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Petersen	US 3,371,823	Mar. 5, 1968
Sundstrom	US 5,082,144	Jan. 21, 1992

REJECTIONS

Claims 1, 3 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Petersen and Sundstrom. Ans. 3.

OPINION

There is nothing intrinsically wrong with defining something by what it does rather than what it is while drafting a patent claim. *See In re Swinehart*, 439 F.2d 210, 212-13 (CCPA 1971). When applicants use

functional language to differentiate the claimed subject matter from the prior art, it is incumbent upon the Examiner to show that the prior art is capable of performing the claimed function. *See id.* In this instance, we give patentable weight to the claim 1 functional language of "to progressively bring skin edges together", since it gives meaning and vitality to the preambular recitation of "closing skin edges" and it is referred to in the ultimate clause of the claim which is directed to "the skin edges being brought together."

In the case before us, the Examiner has not clearly articulated a factual finding that Petersen has structure, such as the end caps (or wheels) 7, that is capable of progressively bringing the skin edges together if the device of Petersen were to be moved along a wound. The Examiner's failure to support such a finding, on its own, is a sufficient ground to reverse the rejection. It is our finding, in fact, that the end caps or wheels 7 of Petersen would not function to progressively bring skin edges together. Thus we agree with Appellant's argument that the skin edges are brought together by Appellant's opposing wheels, which is unlike Petersen's structure or function. Br. 3:5. Accordingly, the combination of Petersen and Sundstrom would not have rendered the subject matter of claim 1 prima facie obvious at the time the invention was made.

We further agree with the Appellant that the press lever 23 of Petersen cannot be read as plural buttons coupled to the wheels 7.

DECISION

The 35 U.S.C. § 103 rejection of claims 1, 3, and 4 is reversed.

Appeal 2009-011649
Application 10/805,856

REVERSED

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